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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,519	04/26/2000	Peter V. Boesen M.D.	P04179US0	9687

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MCKEE, VOORHEES & SEASE, P.L.C.  
801 GRAND AVENUE  
SUITE 3200  
DES MOINES, IA 50309-2721

EXAMINER

NGUYEN, DINH X

ART UNIT PAPER NUMBER

3626

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/558,519

Applicant(s)

BOESEN M.D., PETER V. 

Examiner

Dinh X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 35,36 and 68-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 35,36 and 68-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 35 and 36 in Paper No. 10 is acknowledged. The election is considered without traverse since Applicant has canceled the non-elected claims and presented new claims for consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 36 and 71-83 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Evans, USPN 6,347,329 or Lonski et al., USPN 6,338,039 or Walters et al., USPN 6,393,404.

Claim 35 calls for a method for providing point of service medical billing using a computer comprising:

Receiving a selection of patient procedure code from a care provider on a first computer at a point of service;

Receiving a selection of a diagnosis code from a care provider on the first computer at the point of service;

Electronically sending patient data including the patient procedure code and the diagnosis code from the first computer to a second computer; and

Generating a patient bill at the second computer, the patient bill associated with the patient data.

Claim 36 is a method claim similar to claim 35 calling for one computer to be called the back-end computer, claim 78 calls for a software article stored on a storage medium as an equivalent to the method claims.

Applicant's thrust of the invention appears to be the usage of two or more computers instead of one with respect to collection of information and billing. The use of procedural and diagnosis codes for billing purposes are disclosed in the prior art as cited below and Examiner takes official notice that this method is well known in the art.

Evans discloses the use of two or more computers, codes and multiple databases (abstract, col. 2 lines 50-55) in billing processes (col. 1 lines 19-36). See also col. 8 line 66 to col. 9 line 19 and col. 11 line 42 to col. 12 line 2 with respect to the codes.

Lonski et al. disclose billings using relational databases (col. 2 lines 13-17, claim 11), using portable computers, and therefore more than one computers are used (col. 3 lines 8-13), with the application of codes (col. 21 line 49 to col. 22 line 5, appendix at col. 22). See also col. 9 lines 56-67 and claim 10 for example.

Walters et al. also disclose using multiple computers (fig. 1, col. 3 lines 6-19, col. 2 lines 30-33), with codes for billing purposes (fig. 2, fig. 4, col. 2 lines 22-29, col. 2 lines 34-39). See col. 1 line 41-52 with respect to a modifier code for the dependent claim. See also col. 1 line 23-40 with respect to the codes. It is disclosed that codes are used for billing purposes (see col. 1 lines 24-25 and 53-59, col. 2 lines 23-29, col. 3 lines 63-65).

Examiner furthermore takes official notice that the claims read on normal practices in the healthcare profession, as based on Examiner's personal knowledge. When one leaves a doctor office, the receptionist pulls up a screen indicating the charges which the patient has to pay before leaving. This computer is obviously linked to others

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via either the intranet, LAN or the internet to another computer which has the database of the diagnosis and procedure involved in the medical visit. As stated above, procedural and diagnosis codes are routinely used. Thus, it is either inherent or obvious to one of ordinary skill in the art that codes are used in the billings in a hospital or HMO.

With respect to the dependent claims, see citations above. As noted throughout the references, the use of procedural and diagnosis codes for billing purposes is well known such that features such as selecting from a list of codes are also well known in the art. Examiner further takes official notice that these features and that of communication between more than one computer are well known in the medical art and the field of relational databases and telecommunications.

Claims 68-70 are rejected under 35 U.S.C. 103(a) as obvious over Evans, USPN 6,347,329 or Lonski et al., USPN 6,338,039 or Walters et al., USPN 6,393,404. Evans, Lonski et al. and Waters et al. do not explicitly disclose presenting the billing to a patient prior to departure, verifying accuracy of information and wireless communication between two computers. However, Examiner takes official notice that these practice and form of communications are well known and obvious to one of ordinary skill in the art of healthcare and telecommunication.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shults et al., USPN 6,324,516, Chicorel, USPN 6,192,345,

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Dorne, USPN 5,325,293 and Erickson, USPN 5,229,584 all disclose using procedural or diagnosis codes for patient billing services. The following references as submitted in Applicant's IDS appears relevant and are applicable in art rejections. The article "Tiny computers come in handy, doctors find" discloses the TRGpro, a palm-top computer which doctors use for coding of medical procedures and diagnosis in order to ensure proper payment (second column). Ballantyne et al., USPN 5,867,821 disclose individual patient care stations interconnected to a master library providing a medical information network (abstract); figures 1 and 6 show multiple computer connections; and col. 2 lines 43-45 indicate billing services. Evans, USPN 5,924,074 is the parent of '329 as applied in the office action. Dirbas, USPN 6,125,350 discloses computer systems using databases for record keeping and billing services (abstract), utilizing codes (figures 6B+). Rensimer et al., USPN 6,154,726 disclose systems and methods utilizing codes at the point of care-provider (abstract).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh X. Nguyen whose telephone number is (703) 305-3522. The examiner can normally be reached on Monday to Thursday and alternate Fridays..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703)



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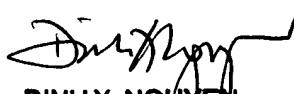
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305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

DXN  
November 25, 2002

  
**DINH X. NGUYEN**  
**PRIMARY EXAMINER**